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APR 08 2009

OFFICE OF PETITIONS

In re Application of :
Harold Bennett : DECISION ON PETITION
Application No. 09/994,560 :
Filed: November 27, 2001 :
Atty Docket No. 31088-2 :

This is a decision on the paper styled PETITION TO REVIVE ABANDONED PATENT¹ IN ACCORDANCE WITH 37 C.F.R. §1.137(a), (b) filed July 16, 2008 (and revised December 2, 2008). Receipt of the status letter filed January 22, 2009 is acknowledged.

The petition under 37 CFR 1.182 is **DISMISSED**.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(b)."

¹ It is noted that this petition in error references the patent of another inventor. This decision is limited to consideration of the abandonment of application No. 09/994,560. The revised petition filed December 2, 2008 corrected this error.

The above-identified application became abandoned for failure to file a reply to the final Office action mailed January 15, 2003. This Office action set a shortened statutory period for reply of three (3) months, with extensions of time obtainable under § 1.136(a). No reply considered received and no extension of time considered obtained, this application became abandoned effective April 16, 2003. A courtesy Notice of Abandonment was mailed on November 28, 2003.

Almost 5 years later, applicant filed the instant petition. Applicant petitions to revive this application, pursuant to 37 C.F.R. § 1.182, or, alternatively under § 1.137(a) or (b). Applicant maintains that the response was timely filed by facsimile transmission to the Office on May 15, 2003, with a request for a 1 month extension of time and the requisite fee. Applicant petitions to revive this application, pursuant to 37 C.F.R. § 1.182, or, alternatively under § 1.137(a) or (b).

RELEVANT STATUTES AND RULES

37 CFR 1.182

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

35 U.S.C. 133 provides that:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

As stated in MPEP 711.03(c),

35 U.S.C. 41(a)(7) allows for payment of a fee to revive an application for a patent abandoned unintentionally. The legislative history of Public Law 97-247, § 3, 96 Stat. 317 (1982), reveals that the purpose of 35 U.S.C. 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion stating that "[u]nder this section a petition accompanied by [the requisite fee] would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71.

35 U.S.C. 41(a)(7) provides that a petition for the revival of an unintentionally abandoned application or for the unintentionally delayed payment of the issue fee must be accompanied by the petition fee set forth in 37 CFR 1.17(m), unless the petition is filed under 35 U.S.C. 133 or 151 (on the basis of unavoidable delay), in which case the fee is set forth in 37 CFR 1.17(l). Thus, unless the circumstances warrant the withdrawal of the holding of abandonment (i.e., it is determined that the application is not properly held abandoned), the payment of a petition fee to obtain the revival of an abandoned application is a statutory prerequisite to revival of the abandoned application, and cannot be waived.

In addition, the phrase "[o]n filing" in 35 U.S.C. 41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), reprinted in 1982 U.S.C.C.A.N. 770 ("[t]he fees set forth in this section are due on filing the petition"). Therefore, the Office: (A) will not refund the petition fee required by 37 CFR 1.17(l) or 1.17(m), regardless of whether the petition under 37 CFR 1.137 is dismissed or denied; and (B) will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee.

The phrase "unless the petition is filed under [35 U.S.C.] 133 or 151" signifies that petitions to revive filed on the basis of "unavoidable" delay (under 35 U.S.C. 133 or 151) are a subset of petitions to revive filed on the basis of unintentional delay. That is, "unavoidable" delay and "unintentional" delay are not alternatives; "unavoidable" delay is the epitome of "unintentional" delay. Any petition to revive an abandoned application or lapsed patent must meet the minimal "unintentional" delay threshold, and an applicant need only pay the fee specified in 37 CFR 1.17(l) (rather than the fee specified in 37 CFR 1.17(m)) if the petition is also accompanied by an adequate showing that the entire delay in filing the required reply, from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a), was unavoidable.

37 CFR 1.137(a) provides:

If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

37 CFR 1.137(b) provides:

If the delay in reply by applicant was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

OPINION

Applicant petitions to revive this application, pursuant to 37 C.F.R. § 1.182, or, alternatively under § 1.137(a) or (b). Applicant maintains that the response was timely filed by facsimile transmission to the Office on May 15, 2003, with a request for a 1 month extension of time and the requisite fee.

Petition under 37 CFR 1.182

Applicant submits a payment of \$400 for consideration of this petition under 37 CFR 1.182. Pursuant to 37 CFR 1.182, applicant asks for a determination by the Director that the application was never properly abandoned, because the response was timely filed, and that, rather than a Notice of Abandonment, the Office should have either allowed the application or issued an Office Action stating the grounds for continued rejection or objections. Relief by way of petition under 37 CFR 1.182 is for questions not specifically provided for in the regulations. In other words, it is for matters not otherwise provided for in the regulations. The question of whether the holding of abandonment should be withdrawn is provided for in the regulations at 37 CFR 1.181 by way of petition to withdraw holding of abandonment (and the question of whether the application should be revived is provided for in the regulations at 37 CFR 1.137).

Accordingly, the petition under 37 CFR 1.182 is **DISMISSED**.

Prior to considering applicants alternative petitions under 37 CFR 1.137, it is appropriate to address withdrawal of the

holding of abandonment pursuant to 37 CFR 1.181. 37 CFR 1.181(f) provides that, *inter alia*, except as otherwise provided, any petition not filed within 2 months from the action complained of may be dismissed as untimely. Therefore, any petition (under 37 CFR 1.181) to withdraw the holding of abandonment not filed within 2 months of the mail date of a notice of abandonment (the action complained of) may be dismissed as untimely. 37 CFR 1.181(f). See MPEP 711.03(c).

More importantly, where the record indicates that the applicant intentionally delayed the filing of a petition to withdraw the holding of abandonment, the Office may simply dismiss the petition as untimely (37 CFR 1.181(f)) solely on the basis of such intentional delay in taking action in the application without further addressing the merits of the petition.

The record in this instance supports a conclusion that applicant intentionally delayed filing this petition. The application became abandoned effective April 16, 2003. However, this petition was not filed until 5 years later.

Applicant's contention that he only recently became aware of the abandonment is unavailing. The record supports a conclusion that applicant via his counsel was made aware of non-receipt of the response by virtue of a telephone call from the Examiner in July of 2003, and then, was made aware of abandonment of the application by virtue of a courtesy Notice of Abandonment mailed on November 28, 2003. The petition fails to adequately explain the delay in taking action after receipt of the Notice of Abandonment. The fact that the inventor never received a copy of the Notice of Abandonment from his attorney is irrelevant. There is no doubt that the inventor's voluntarily-chosen representative received the Notice.

Most importantly, there is no adequate explanation for the extended period of inaction on this application. The question arises as to whether during this time the inventor continued to seek prosecution of this application. The application file reveals no action in this case after abandonment. Inconsistent with any conclusion that applicant thought prosecution was continuing after the abandonment, not a single status inquiry is of record. Further, petitioner has submitted no records to show their efforts during this period. In fact, the petition shows that attorney for applicant had to retrieve the application file from off-site storage when the inventor contacted them in 2008.

Further, the declaration of inventor Bennett suggests that changes in circumstances (increase in oil prices) caused him to now check the status of his application and seek revival. There is an inference from these facts that at some point inventor Bennett intentionally ceased to seek prosecution of this application and now circumstances have changed and he wishes to continue prosecution. It is well-established that a change in circumstances that occurred subsequent to the abandonment of an application does not render "unintentional" the delay resulting from a previous deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue the prosecution of an application with why there was a deliberate decision not to continue the prosecution of an application.

Accordingly, the Office will not address, in the context of a petition to withdraw the holding of abandonment under 37 CFR 1.181, the merits of applicant's contention that the response was timely filed.

Petition under 37 CFR 1.137

Likewise, intentional delay in seeking the revival of an abandoned application precludes relief under 37 CFR 1.137(a) or (b). Petitioner argues that the abandonment was not the product of any delay in filing a response to the Office action, and, therefore, it was unavoidable. However, the question is not merely applicant's delay in filing the required reply. A petition under 1.137 cannot be granted where petitioner has not met his burden of showing that the entire delay, including the delay in filing the petition was "unintentional" or "unavoidable."

Petitioner states and submits records to show that they spoke with the examiner and discussed the timely facsimile transmission. The examiner did not have the transmission, but thought it might be in scanning. Petitioner argues that they believed this matter was resolved as they received no request for another copy of the response from the examiner.

However, this matter being resolved is inconsistent with the record. Petitioner acknowledges that at the time they maintain they facsimile transmitted the response there was a question as to receipt of the facsimile transmission. Yet, despite this

question, it appears that no continuing action, such as a status inquiry, was taken to verify that the matter was resolved and prosecution continued in the application. It is acknowledged that no request for another copy of the response was mailed by the examiner. Yet, at the same time no Office action was mailed by the examiner in response to applicant's response. In fact, as previously noted, a notice of abandonment was mailed. Yet, the instant petition was filed July 16, 2008, more than 5 years after the abandonment.

The burden of proof to show that the cause of the delay was "unintentional" (or "unavoidable") is on applicant. Thus, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(a) or 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application.

It is well established that a delay resulting from a deliberately chosen course of action on the part of the applicant is not an "unintentional" delay within the meaning of 37 CFR 1.137(b). Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See In re Maldague, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988). A delay resulting from a deliberately chosen course of action on the part of the applicant does not become an "unintentional" delay within the meaning of 37 CFR 1.137(b) because:

- (A) the applicant does not consider the claims to be patentable over the references relied upon in an outstanding Office action;
- (B) the applicant does not consider the allowed or patentable claims to be of sufficient breadth or scope to justify the financial expense of obtaining a patent;

(C) the applicant does not consider any patent to be of sufficient value to justify the financial expense of obtaining the patent;

(D) the applicant does not consider any patent to be of sufficient value to maintain an interest in obtaining the patent; or

(E) the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses.

Likewise, a change in circumstances that occurred subsequent to the abandonment of an application does not render "unintentional" the delay resulting from a previous deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue the prosecution of an application with why there was a deliberate decision not to continue the prosecution of an application.

Proof that the response was timely filed by facsimile transmission supports a conclusion that the delay was unintentional. However, the circumstance of the abandonment cannot overcome intentional delay in failing to take action to revive the application (or to withdraw the holding of abandonment). There is a real question as to whether there was ever a deliberate decision not to continue prosecution of this application. In view thereof, it is appropriate to request additional explanation as to why the delay in filing a response to the Office action and in filing a petition should be considered unintentional (or unavoidable).

Further correspondence with respect to this decision should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
ATTN: NANCY JOHNSON
SENIOR PETITIONS ATTORNEY

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries specific to this matter should be directed
to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized initial "N" and "J".

Nancy Johnson
Senior Petitions Attorney
Office of Petitions